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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/461,375 12/15/99 GUERET

J 2350-76

EXAMINER

HM22/0712

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ARLINGTON VA 22201-4714

CHOICE	
ART UNIT	PAPER NUMBER

1616

DATE MAILED:

07/12/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.

09/461,375

Applicant(s)

GUERET, JEAN-LOUIS

Examiner

Frank I Choi

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-19 is/are pending in the application.
- 4a) Of the above claim(s) 10-14 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-9, 15 and 17-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Élection/Restrictions

This application contains claims 10-14, 16 drawn to an invention nonelected with traverse in Paper No. 5. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01. New claims 18, 19 appear to be directed to the elected invention and will be prosecuted accordingly.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2-9, 15, 17-19 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for ethylhexyl acrylate/vinyl acetate/acrylic acid copolymer, nylon or polymethyl methacrylate powders in the disclosed ranges does not reasonably provide enablement for non-ionic and non-water-swellaable copolymers of acrylic/vinylic type, all fillers or having components per se without indicating amounts for the reasons of record set forth in the prior Office Action and the further reasons below.

Examiner has duly considered Applicant's argument but deems them unpersuasive. Examiner is not required to support by reference to literature what is common knowledge. Addition of other components, fillers or otherwise, will effect the adhesiveness of a given adhesive by the simple dilution of the adhesive or if said components have adhesive properties will add to the adhesive properties of the composition as a whole. Further, even the Specification indicates that not all fillers are suitable for the invention. As such, in light of the

Art Unit: 1616

limited disclosure, a skilled artisan would be required to do undue experimentation in order to determine a suitable polymer and filler and amounts thereof and amounts of the other components, other than as specifically disclosed in the Specification, which would result in a composition having the claimed properties.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-9, 15, 17-19 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that said claims fail to correspond in scope with that which applicant(s) regard as the invention can be found in Paper No. 5 filed 11/6/00. In that paper, applicant has stated the compositions contain no water, and this statement indicates that the invention is different from what is defined in the claim(s) because the claims do not clearly indicate that they may not contain water. Examiner has duly considered Applicant's arguments but deems them unpersuasive. In the first instance the list of solvents is contained in the preamble and not the body of the claim. In the second instance, although water is not listed as an organic solvent, the claim as a whole does not appear to exclude water.

Claims 2, 19 recite the limitation "polymer consists of units derived from monomers selected from . . . ". There is insufficient antecedent basis for this limitation in the claims as claim 18 on which claim 2, 19 are dependent indicates that the polymer is a co-polymer whereas the limitation above appears to allow polymers formed from one type of monomer.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-9, 15, 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Higo et al. (WO 96/16642) (*Examiner has provided the English language equivalent, U.S. Pat. 5,866,157, for Applicant's convenience*).

Higo et al. teach an adhesive containing a physiological active substance, organic acid, a hydrophobic high molecular material, a tackifying resin, plasticizer and absorption enhancer (Pg. 4, lines 9-14) (*Column 2, lines 45-53*). It is taught that the organic acids include lactic acid, maleic acid and salicylic acid (Pg. 4, lines 16-27) (*Column 2, lines 56-68*). It is taught that copolymers containing at least two materials selected from 2-ethylhexyl acrylate, vinyl acetate, methacrylate, methoxyethyl acrylate and acrylic acid are suitable as the hydrophobic high molecular material (Pg. 7, lines 4-14) (*Column 3, lines 64-68, Column 4, lines 4-8*). It is taught that absorption enhancers include geraniol, thymol, eugenol, terpineol, 1-menthol, bonreol, d-limonene, isoeugenol, isoborneol, nerol (Pg. 9, lines 7-26, Pg. 10, lines 1-15) (*Column 4, lines 60-68, Column 5, lines 1-22*). It is taught that the adhesive layer can contain antioxidants, fillers and ultraviolet absorbers, for example, tocopherol, ascorbic acid, calcium carbonate, magnesium carbonate, silicates, silicic acid, barium sulfate, calcium sulfate, calcium zincate, zinc oxide, titanium oxide and salicylic acid derivatives (Pg. 10, lines 23-26, Pg. 11, lines 1-25) (*Column 5, lines 33-63*). It is taught that the adhesive may be prepared by dissolving the base

components containing drugs in a solvent such as ethyl acetate and the like and removing the solvent by drying (Pg. 12, lines 5-12) (*Column 6, lines 3-9*).

The difference between the cited reference and the claimed invention is that the prior art does not expressly disclose a colorless solution for cosmetic use, based on a hydrophobic polymer in an organic solvent medium selected from the group consisting of ethyl acetate, ethyl alcohol, isopropyl alcohol and mixtures thereof which contains at least one self-adhesive hydrophobic polymer which is of linear structure, non-ionic and non-water swellable and is selected from copolymers of the acrylic/vinylic type, at least one compound selected from the group consisting of a filler and an essential oil, and at least one keratolytic agent, said polymer having an adhesiveness of between 150 and 800 g/square centimeter after evaporation of said organic solvent medium. However, the cited reference amply suggests the same as it is known in the art to combine various components into vinylic/acrylic copolymer adhesives including cosmetic compounds, organic acids, fillers and essential oils. As such, it would have been well with the skill of one of ordinary skill in the art to modify the prior art as above with the expectation that the pharmaceutical incorporated therein would be absorbed faster and the formulation would exhibit extremely reduced skin irritation (Pg. 12, line 26, Pg. 13, lines 1-6) (*Column 6, lines 29-38*).

Therefore, the claimed invention, as a whole, would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention has been collectively taught by the combined teachings of the references.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1616

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

A facsimile center has been established in Technology Center 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machines are (703) 308-4556 or (703) 305-3592.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Choi whose telephone number is (703) 308-0067.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. José Dees, can be reached on (703) 308-4628.

FIC

July 6, 2001



JOHN PAK
PRIMARY EXAMINER
GROUP 1600

